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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/432,434	04/28/95	PECK	A UF141.C1

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18M2/0904

LANKFORD, TH. L.  
EXAMINER

ART UNIT PAPER NUMBER

1808

DATE MAILED:

09/04/96

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

<b>Office Action Summary</b>	Application No. <b>08/432,434</b>	Applicant(s) <b>Peck et al</b>
	Examiner <b>L. Blaine Lankford</b>	Group Art Unit <b>1808</b>

Responsive to communication(s) filed on Apr 26, 1996

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-25 is/are pending in the application.

Of the above, claim(s) 1-16, 18, 20, 24, and 25 is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 17, 19, and 21-23 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

**Part III DETAILED ACTION**

I. Applicant's election without traverse of claims 17, 19 & 21-23 in Paper No. 9 is acknowledged.

II. Claims 17, 19 and 21-23 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "pancreas-like" renders the claims indefinite. It is unclear what would constitute a "pancreas-like" organ. The limitations of "-like" are not unclear and undefined.

III. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order

for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

IV. Claims 17, 19 and 21-23 are rejected under 35 U.S.C. § 103 as being unpatentable over Reemtsma et al (A).

Applicant claims a method for producing a "pancreas-like" organ by implanting islet cells into an animal.

Reemtsma teaches implanting islet cells into an animal to produce an artificial pancreas. Applicant appears to claim that the cells can be implanted free of other substances, while the prior art teaches that the cells are to be accompanied by a matrix. It would be a matter of design choice to include or exclude a matrix with the implanted cells. The art generally teaches that the addition of such a matrix is desirable to give the artificial organ the proper three dimensional structure. Although the art does not teach implanting human cells, it would have been obvious to one of ordinary skill in the art at the time the invention was made to extend the teachings of Reemtsma to humans as mice as acceptable models in transplantation study.

Accordingly, the claimed invention was prima facie obvious to one of ordinary skill in the art at the time the invention was made especially in the absence of evidence to the contrary.

V. Any inquiry concerning this communication or earlier communications from the examiner should be directed to L. Blaine Lankford whose telephone number is (703) 308-2455.

LBL  
September 3, 1996

  
BLAINE LANKFORD  
PATENT EXAMINER  
GROUP 1800